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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,642	04/02/2004	Kia Silverbrook	HYC007US	9566
24011 7590 02/05/2009 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA				
EXAMINER				
UBER, NATHAN C				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/815,642

**Applicant(s)**

SILVERBROOK ET AL.

**Examiner**

NATHAN C. UBER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 10, 12 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10, 12 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Status of Claims

1. This action is in reply to the amendment filed on 13 November 2008.
2. Claims 1, 10, 12, and 29 have been amended.
3. Claims 4-9, 11, 13-28 and 30-38 have been canceled.
4. Claims 1-3, 10, 12 and 29 are currently pending and have been examined.

### Double Patenting

5. Claims 1-3, 5, 7, 10, 12, 13, 18, 28 and 29 were rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-50 of prior U.S. Patent No. 7,137,549. Claims 4-9, 11, 13-28 and 30-38 were canceled by Applicant's amendments on 21 May 2008 and 13 November 2008. Further Applicant amended claims 1, 10, 12 and 29 in an attempt to overcome this rejection.
6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
7. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this

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application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

8. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
9. Claims 1-3, 10, 12 and 29 are rejected on the ground of nonstatutory double patenting over claims 1-50 of U. S. Patent No. 7,137,549 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: at least claim 1 of the '549 patent discloses that the coded information is on the product label which is also on the surface of the product. Further at least claim 1 the '549 patent discloses "coded data for determining a unique product identifier" and in fact what the coded data means, i.e. the content of pure data, does not patentably affect the scope of the claims. Further the position data limitations added by amendment to claims 10, 12 and 29 are not different from the cited patent.
10. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### **Claim Objections**

11. Claim 28 was objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant canceled claim 28, so the objection is moot.

#### **Claim Rejections - 35 USC § 112**

12. Claim 12 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

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invention. Applicant's amendment adequately addresses this rejection, accordingly the rejection is withdrawn.

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant added the limitation that the coupon data is printed directly on the surface of a product. This limitation does not appear in the original disclosure and is therefore rejected as being impermissible new matter.

#### **Claim Rejections - 35 USC § 102**

15. Claims 18 and 28 were rejected under 35 U.S.C. 102(b) as being anticipated by Murphy et al. (4,554,446). Applicant canceled claims 18 and 28, the rejection is therefore moot.

#### **Claim Rejections - 35 USC § 103**

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
18. Claims 1-3, 10, 12 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. (4,554,446) in view of Lazzouni et al. (U.S. 5,661,506).

**Claims 1-3 and 29:**

Murphy discloses an inventory control method that uses a combination of machine readable and human readable indicia on product labels and coupons to track inventory, manage pricing, and conduct various incentive promotions electronically using a combination of point of sale machines and computers. (See at least Figures 1 and 2, see also column 4, lines 27-32). Product identification is discussed with reference to the UPC code (see at least column 3, lines 60-66), however Murphy also more broadly discloses bar codes which may be used to identify more than just UPC data and anticipates or at least renders obvious Applicant's added limitation of uniquely identifying the "product item." Murphy particularly notes several different types of coupons including coupons disposed on the product itself as well as coupons that require the customer to transmit customer identification data to the product manufacturer. Murphy points out that in situations where coupons require interaction from the customer, many customers cannot be bothered (a sentiment echoed in applicant's specification), so Murphy solved this problem by creating coded forms and ID cards so that the customer can simply transmit requisite personal information electronically by swiping or entering their coded information. The coupon redemption methods are discussed broadly in columns 9 and 10. Lines 9/18-29, 9/48-61 and 10/22-46 are particularly relevant to applicant's claims

directed towards transmission of coupon and customer information as well as submitting electronic forms.

Further with respect to the limitations of claim 1 directed to sensing machine readable code, position data and redemption information, Murphy discloses at least two sensing steps (swipe and scan) as well as receiving and transmitting redemption information as previously discussed. Further the barcode scanning of Murphy inherently requires the generation of position data as this is the basis for successful bar code scanning. The sensing device must identify the position of the registration posts on the bar code before it can interpret the code residing between the posts. Additionally the position of the bar code itself is inherently valuable to the sensing and data gathering step, especially for products or barcode sheets that may have multiple bar codes. However, Murphy does not disclose the narrower interpretation of *interaction data* as may be gleaned from the specification. Lazzouni, in at least column 4, lines 16-17, 25-26, 34-38, 46-50, 57-59 and in Figure 1 discloses generating interaction data based on sensing the position of a scanning device on substrate that is coded with infrared machine readable coordinate code. It would have been obvious to one having ordinary skill in the art at the time of the invention to enhance the Murphy invention by integrating additional coded data into printed labels and coupons since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claims 10 and 12:**

Murphy does not disclose the limitations of claims 10 and 12. However, Lazzouni in at least in at least column 4, lines 16-17, 25-26, 34-38, 46-50, 57-59 and in Figure 1 discloses generating interaction data based on sensing the position of a scanning device on coded substrate. The *interaction data* includes a digital representation of writing (see at least Figure 1) and movement data (see at least column 4, lines 46-50).

**Claims 10, 12 and 29:**

With respect to Applicant's newly added limitation in claims 10, 12 and 29, *the coded data further comprises position data identifying a position of the sensing device relative to the coupon*, the cited combination Murphy/Lazzouni discloses this limitation as shown above. The Lazzouni reference discloses a coded surface that is capable of generating interaction data representative of the position of the sensing device relative to the coded surface. Murphy discloses placing coupons on surfaces and using codes printed on surfaces to represent coupons. The combination of the references embraces identifying the location of the sensing device relative to anything printed on the coded surface.

**Response to Arguments**

19. Applicant's arguments filed 13 November 2008 have been fully considered but they are not persuasive. Applicant argues that the prior art of record fails to teach the claimed invention because the primary reference "teaches providing a voucher having a machine readable code on the voucher itself" allowing the voucher to be identified. Further that "products identified through a Universal Product Code (bar code)... does not identify the product item" individually, but rather generically. Examiner disagrees with Applicant's narrow characterization of a "bar code." While UPCs may be limited by definition to generic identification, a bar code is not so limited. Bar codes are computer readable code that may be used to represent any data. It is not novel to use bar codes to uniquely identify individual items; in fact many inventory systems track items individually. For example, computer equipment inventory systems in university, corporate and government organizations use barcodes to track individual equipment issued to individual employees/students.
20. Applicant further argues that the claimed invention is different from and patentable over the cited prior art because "the coupon [in the claimed invention] is associated with the product item by being printed on the product item." In fact Murphy discloses printing coupons directly on the product packaging (see at least column 9, lines 31-42 and lines 48-61). Additionally Murphy also



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teaches printing on product labels which are attached to the product. Examiner does not narrowly construe "printing on the product item" to mean actually printing on the product (i.e. printing code on the bread or chips or diapers) but printing code on the product label or product package. Further the limitation of printing the coupon directly on the product item is new matter as it does not appear in the original disclosure, see the 112 rejection above. Examiner is not convinced by Applicant's argument that the invention is novel and unobvious over the cited prior art because the prior art teaches all of the claimed limitations.

**Conclusion**

21. The previous prior art rejections are maintained in this action and Applicant's arguments have all been addressed above. Applicant's amendment necessitated the change to the prior double patenting rejection. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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23. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
25. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**P.O. Box 1450, Alexandria, VA 22313-1450**

or faxed to **571-273-8300**.

26. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building  
401 Dulany Street  
Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622  
31 January 2009

/Arthur Duran/  
Primary Examiner, Art Unit 3622